

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hugh James O'Donnell
Serial No.: 10/522,191
Filed: 01/25/2005
Group Art Unit: 1794
Examiner: Gray, Jill M.
Conformation No.: 1477
Title: ELEVATOR BELT ASSEMBLY WITH PRESTRETCHED
SYNTHETIC CORDS

REPLY BRIEF

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed on October 6, 2009.

The Examiner has utterly failed to establish a *prima facie* case of anticipation or obviousness against any of Appellant's claims. The Examiner appears to be attempting to shift the burden to Appellant. On pages 7 and 8 of the Examiner's Answer, for example, the Examiner states that there is "no clear factual evidence on this record that the cords of Baranda are not stretched or lengthened" and "there is no clear factual evidence on this record to clearly substantiate appellants' argument that the belt of Baranda has elastic stretch." It is not Appellant's burden to come forward with evidence to prove a negative. Rather, it is the Examiner's burden to establish that the references teach enough to establish a *prima facie* case of anticipation or obviousness in the

first place. All that Appellant needs to do – and has done – is point out that the references are silent or void of teachings showing the claimed elements.

The point of Appellant's arguments is that the Examiner has not and cannot establish a *prima facie* case of anticipation or obviousness because the references are completely silent regarding any type of stretching of cords that would lengthen them or increase their length. Without some express teaching of that, there is no *prima facie* case against any of Appellant's claims.

The Baranda reference.

In the case of the *Baranda* reference, the Examiner states that “the skilled artisan would immediately envisage the strength or load bearing capabilities to hold an elevator,” when discussing Appellant's argument regarding the low tension force described in the *Baranda* reference. The Examiner's observation proves Appellant's point. An elevator belt needs to support substantial loads. A 50 Newton tension for holding the cords straight during a belt manufacturing process is completely insufficient to stretch cords that are strong enough to support the far more substantial loads associated with an elevator system. If a 50 kg load (e.g., about 100 lbs) were sufficient to lengthen the cords of a belt, that belt would not be acceptable to one skilled in the art as an elevator belt. In other words, a plain reading of the *Baranda* reference demonstrates that the tension applied in that reference is not sufficient to lengthen the cords. Therefore, it is not possible to establish a *prima facie* case of anticipation or obviousness based upon the *Baranda* reference.

The Examiner's entire analysis ignores or attempts to read out the limitations from Appellant's claims pertaining to stretched or lengthened cords. The Examiner appears to simply say any tension is enough to increase the length of a cord. That is not true. It is not Appellant's burden to claim any particular load to lengthen the cords. It is enough that the claims state that the

cords are lengthened. It is the Examiner's burden to show that the references teach that. None of them do. There is no *prima facie* case of anticipation or obviousness.

The Prewo reference.

When discussing the *Prewo* reference and the corresponding rejections, the Examiner again attempts to shift an improper burden to the Appellant. Appellant has explained why there is no *prima facie* case because of the silence of the references regarding the limitations of Appellant's claims.

Additionally, the *Prewo* reference teaches a situation that is the opposite of the limitations of at least some of Appellant's claims. Any stretching that occurs in the *Prewo* reference occurs because of an external load (e.g., the load of the elevator system) placed on the belt. At least Appellant's claims 7-15, as explained in the opening brief, include limitations regarding having the belts in a lengthened, pre-stretched state even without any external load applied to them. That is nowhere taught within the *Prewo* reference. In fact, it teaches the opposite because it only teaches stretching as a result of being subject to an external load.

Product by process.

With regard to the product by process limitations, Appellant has pointed out structural differences between the claim limitations and the teachings of the references. The Examiner's contention that there is "no factual basis" for the distinctions is wrong. There are claim limitations as explained by Appellant in its opening brief that cannot be satisfied by taking the teachings of the references relied upon by the Examiner.

On page 9 of the Examiner's Answer, the Examiner states, "it is the examiner's position that once the examiner provides a rational tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden

shifts to applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.” The Examiner’s problem in this case is that there has been no showing that the claimed product appears to be the same or similar to that of the prior art. Apart from that, similarity is not sufficient. The art must be able to be read upon the limitations of the claims. That cannot be done in this case for the reasons stated in Appellant’s opening brief.

Claim 2

Regarding claim 2, the Examiner appears to object to Appellant’s characterization of the load recited in claim 2. On the one hand, the Examiner says that Appellant never sets any limit on the load. On the other hand, the Examiner now ignores the limitations placed on the load in claim 2. An applicant is free to characterize limitations of the claim in any way that otherwise meets the statutory requirements. The limitations of claim 2 are clear to one skilled in the art and place limitations on the load that is used for increasing the length of the cords. There is simply no basis for the Examiner’s position regarding claim 2.

Claims 4 and 12 are allowable.

Given the withdrawal of the rejection based upon the *Lambert* reference, which Appellant appreciates, there is no remaining rejection of claims 4 and 12. At a minimum, those claims are allowable because there is no remaining rejection of those claims.

For all the reasons presented above, the remaining rejections must be reversed.

Corrections to Appellant’s opening brief.

Appellant apologizes for any inconvenience to the Board but wishes to point out a couple of errors Appellant has recognized in its opening brief. On page 2 under Status of the Claims, the status of claims 2-4, 6, 9 and 11-12 as being rejected under 35 U.S.C. §103 over the *Prewo*

reference is incorrect. That should read as correctly stated under the Grounds of Rejection To Be Reviewed on Appeal that claims 1-3, 6 and 11 stand rejected under 35 U.S.C. §103 as being unpatentable over the *Prewo* reference in view of the *Roberts* reference. The correct statement is contained on page 4 of Appellant's opening brief.

Similarly, the heading on page 11 incorrectly identifies claims 2-4, 6, 9 and 11-12 as rejected under 35 U.S.C. §103 based upon the *Prewo* and *Roberts* references. That heading should read "The Rejection of Claims 1-3, 6 and 11 Under 35 U.S.C. §103 as Being Unpatentable Over the *Prewo* and *Roberts* References Must Be Reversed."

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

December 7, 2009 /David J. Gaskey/
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